APPENDIX A

Filed Feb. 23, 1965

Memorandum Opinion

This is a civil action brought under Title 5, Section 1009 of the Federal Administrative Procedure Act. Plaintiff, Goodyear Tire & Rubber Company, seeks to have the Court enjoin the defendant, Commissioner of Patents, from granting a trademark registration on an application Serial No. 172,441, filed by Weather-Rite Sportswear Co., Inc., for the mark "GOODYEAR DELUXE BY WEATHERITE".

Weather-Rite's application was at first refused by the Patent Office, but then amended, re-examined, passed to issue, and finally published in the Official Gazette on May 12, 1964. Section 12(a) of the Trademark Act of 1946 requires such publication where a mark is found registrable, and Section 13 of the Act creates a right in interested parties to institute proceedings in the Patent Office in opposition to registration of published marks. Plaintiff here neglected through inadvertence to institute such proceedings within the time allotted. The Patent Office, on its own motion, however, later withdrew the mark from issue, refused it registration, and upon re-examination found once again that it was entitled to be registered. The reason for the second re-examination was belated recognition by the Patent Office that the amended statement of goods to be covered was not supported by the Specimens originally filed. Upon submission of new specimens, the mark was again passed to issue, but without republication.

The plaintiff in its amended complaint prays that the Patent Office be directed to publish the mark for an additional period as a consequence of the re-examination. In the alternative, plaintiff asks the Court to direct the Patent Office to withhold registration of the mark pending resolution of another opposition proceeding (No. 44,248, involving "GOODYEAR DELUXE BY IRCO") in the Patent Office

involving similar issues, and pending the outcome of litigation in other federal district courts, also involving similar issues. Plaintiff is a party to both the opposition proceedings in the Patent Office and to the litigation in the other federal courts.

On the day before the registration would have been effected by the Patent Office, this Court granted temporary relief restraining the registration pending a hearing on plaintiff's allegations. Defendant has moved to dissolve the restraining order and to dismiss the Complaint. The plaintiff has moved for summary judgment.

Treating the question of republication first, it seems that this is governed by Rule 2.81 of the Trademark Rules of Practice. The Rule reads in part:

> "If, on examination or re-examination of an application for registration of the Principal Register it appears that the applicant is entitled to have his mark registered, the mark will be published in the Official Gazette for opposition."

The meaning of the term "re-examination" as used in Rule 2.81 is indicated by Rule 2.63, as follows:

> "2.63. Re-Examination. After response by the applicant, the application will be re-examined or reconsidered, ..."

The plaintiff contends that failure to republish the mark for an additional period deprives it of the right to file opposition proceedings against it, and hence denys plaintiff due process of law. The defendant asserts that one publication is enough to satisfy the rule so long as the mark is not amended upon re-examination in such a way as to invite opposition to the mark in its amended form that would not have been invited by its form when originally published. *Carter Medicine Co.* v. *Barclay*, 36 U.S. App. D.C. 123 (1910).

The Court believes the defendant's view of the matter is the sounder. It cannot seriously be argued that inadequacy of specimens would have any significant effect on the decision to oppose the mark by one reading the Official Gazette. If this trademark were republished it would be in the same form as before. The sole effect of republication would be to subject the owner of the mark to a period of exposure twice as great as that normally required, and to do so solely because the Patent Office neglected to make an accurate judgment regarding the specimens at the proper time for so doing.

The plaintiff still has open to it the remedy of having the trademark cancelled by the Patent Office after it is registered. Plaintiff's burden of proof is no greater in cancellation proceedings than it is in opposition proceedings, so it cannot claim injury in that connection. The Court agrees with defendant that the essential purpose of publication has been accomplished, and agrees also that the purpose of the time limitation for filing oppositions would be frustrated by sanctioning exceptions to it on grounds as tenuous as herein set forth.

Plaintiff's alternative prayers for relief have no legal basis of which the Court is aware. The fact that plaintiff is party to one opposition proceeding in the Patent Office does not make it a party to another. It does not have standing to frustrate issuance of a registration it neglected to oppose, even though it did not neglect to oppose one similar to it. Correspondingly, plaintiff's participation in lawsuits throughout the nation cannot confer upon it status before the Patent Office plaintiff has lost through failure to comply with Patent Office rules.

The Court will dissolve the restraining order and dismiss the Complaint.

DATED: February 23, 1965.

JOSEPH R. JACKSON
United States District Judge

APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 19276

THE GOODYEAR TIRE & RUBBER COMPANY, APPELLANT,

v.

THE COMMISSIONER OF PATENTS, APPELLEE

Appeal from the United States District Court
for the District of Columbia

Decided December 29, 1965

As amended February 28, 1966

Mr. Francis C. Browne for appellant. *Mr. Richard G. Kline* also entered an appearance for appellant.

Mr. George C. Roeming, Attorney, United States Patent Office, for appellee. *Mr. Clarence W. Moore,* Solicitor, United States Patent Office, was on the brief for appellee.

Before: PRETTYMAN, *Senior Circuit Judge,* BURGER and LEVENTHAL, *Circuit Judges.*

PER CURIAM: Weather-Rite Sportswear Company made application for the mark "GOODYEAR DELUXE BY WEATHER-

RITE." In accordance with § 12 of the Trademark Act, 15 U.S.C. § 1062, the mark was duly referred to an examiner, and it appearing on examination that the application was entitled to registration, the mark was published for opposition on May 12, 1964.

Appellant failed to file its opposition within the thirty day period provided in § 13 of the Trademark Act, 15 U.S.C. § 1063. Pursuant to a suggestion from appellant the Patent Office subsequently withdrew the Weather-Rite mark from issue and ordered re-examination of the application. The problem was that the originally submitted specimens had not supported the description in the application of the goods to be covered by the mark. Applicant promptly submitted corrected specimens, the Examiner found the mark entitled to registration, and it was passed to issue, to be matured into a registration, without republication.

Appellant seeks in this action to require the Commissioner of Patents to republish the trademark for purposes of opposition. The District Court correctly held, 238 F. Supp. 509, 511, that a second publication is not required unless the mark has been amended "in such a way as to invite opposition to the mark in its amended form that would not have been invited by its form when originally published."

We also agree that the correction of Weather-Rite's specimens was not such a substantial amendment of the application as to require a second publication. *Carter Medicine Co.* v. *Barclay,* 36 App. D.C. 123 (1910), is not to the contrary. The court held the Commissioner was justified in republishing the mark where there had been an

amendment of substance to the trademark application.[1] Appellant's ground for opposition to the mark existed at the time of the publication on May 12, 1964, and is not attributable to applicant's correction of specimens. The Patent Office was justified in issuance on reexamination without a second publication and remitting appellant to its remedy, under § 14 of the Act (15 U.S.C. § 1064), for cancellation of the registration.

Affirmed.

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[1] In *Carter* the court stated (see 36 App. D.C. at 127) that the Commissioner was exercising the discretion given him by the provision of the Trademark Act that "the commissioner shall cause the mark to be published at least once in the Official Gazette of the Patent Office." Act of Feb. 20, 1905, c. 592 § 6, 33 Stat. 726.

The 1905 Act was replaced by the Act of July 5, 1946, c. 540, § 12, 60 Stat. 432. Although the words "at least once" were omitted in the 1946 revision, we do not read this change as a prohibition of a second publication, or as a limitation on the Commissoner's discretion under the *Carter* case.

In *Carter* the court pointed out differences between the original application, for registration of a technical trademark, and the amended application, for registration of a non-technical mark, in terms of the necessary showing and available defenses and said (36 App. D.C. at 126): "It was quite possible for an opposition to lie against the amended application, and not against the original."

APPENDIX C-1

Administrative Procedure Act

JUDICIAL REVIEW

Sec. 10. Except so far as (1) statutes preclude judicial review or (2) agency action is by law committed to agency discretion—

(a) RIGHT OF REVIEW.—Any person suffering legal wrong because of any agency action, or adversely affected or aggrieved by such action within the meaning of any relevant statute, shall be entitled to judicial review thereof.

(b) FORM AND VENUE OF ACTION.—The form of proceeding for judicial review shall be any special statutory review proceeding relevant to the subject matter in any court specified by statute or, in the absence of inadequacy thereof, any applicable form of legal action (including actions for declaratory judgments or writs of prohibitory or mandatory injunction or habeas corpus) in any court of competent jurisdiction. Agency action shall be subject to judicial review in civil or criminal proceedings for judicial enforcement except to the extent that prior, adequate, and exclusive opportunity for such review is provided by law.

(c) REVIEWABLE ACTS.—Every agency action made reviewable by statute and every final agency action for which there is no other adequate remedy in any court shall be subject to judicial review. Any preliminary, procedural, or intermediate agency action or ruling not directly reviewable shall be subject to review upon the review of the final agency action. Except as otherwise expressly required by statute, agency action otherwise final shall be final for the purposes of this subsection whether or not there has been presented or determined any application for a declaratory order, for any form of reconsideration, or (unless the agency otherwise requires by rule and provides that the

action meanwhile shall be inoperative) for an appeal to superior agency authority.

(d) INTERIM RELIEF.—Pending judicial review any agency is authorized, where it finds that justice so requires, to postpone the effective date of any action taken by it. Upon such conditions as may be required and to the extent necessary to prevent irreparable injury, every reviewing court (including every court to which a case may be taken on appeal from or upon application for certiorari or other writ to a reviewing court), is authorized to issue all necessary and appropriate process to postpone the effective date of any agency action or to preserve status or rights pending conclusion of the review proceedings.

(e) SCOPE OF REVIEW.—So far as necessary to decision and where presented the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of any agency action. It shall (A) compel agency action unlawfully withheld or unreasonably delayed; and (B) hold unlawful and set aside agency action, findings, and conclusions found to be (1) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law; (2) contrary to constitutional right, power, privilege, or immunity; (3) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right; (4) without observance of procedure required by law; (5) unsupported by substantial evidence in any case subject to the requirements of sections 7 and 8 or otherwise reviewed on the record of an agency hearing provided by statute; or (6) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court. In making the foregoing determinations the court shall review the whole record or such portions thereof as may be cited by any party, and due account shall be taken of the rule of prejudicial error.

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Trademark Act of 1946, as Amended

Public Law 489, 79th Congress, Chapter 540,
approved July 5, 1946; 60 Stat. 427

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Section 1 (15 U.S.C. 1051). Requirements for registering trademarks on the principal register

The owner of a trademark used in commerce may register his trademark under this Act on the principal register hereby established:

(a) By filing in the Patent Office—

(1) a written application, in such form as may be prescribed by the Commissioner, verified by the applicant, or by a member of the firm or an officer of the corporation or association applying, specifying applicant's domicile and citizenship, the date of applicant's first use of the mark, the date of applicant's first use of the mark in commerce, the goods in connection with which the mark is used and the mode or manner in which the mark is used in connection with such goods, and including a statement to the effect that the person making the verification believes himself, or the firm, corporation, or association in whose behalf he makes the verification, to be the owner of the mark sought to be registered, that the mark is in use in commerce, and that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive: Provided, That in the case of every application claiming concurrent use the applicant shall state exceptions to his claim of exclusive use, in which he shall specify, to the extent of his knowledge, any concurrent use by others, the goods in connection with which and the areas in which each concurrent use exists,

the periods of each use, and the goods and area for which the applicant desires registration;

(2) a drawing of the mark; and

(3) such number of specimens or facsimiles of the mark as actually used as may be required by the Commissioner.

(b) By paying in the Patent Office the filing fee.

(c) By complying with such rules or regulations, not inconsistent with law, as may be prescribed by the Commissioner.

(d) If the applicant is not domiciled in the United States he shall designate by a written document filed in the Patent Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with him or mailing to him a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Commissioner (Amended by Public Law 772, 87th Cong., approved Oct. 9, 1962, 76 Stat. 769).

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Section 12(a) (15 U.S.C. 1062a). Examination of application—*Publication of mark when entitled to registration*

Upon the filing of an application for registration and payment of the fee herein provided, the Commissioner shall refer the application to the examiner in charge of the registration of marks, who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, the Commissioner shall cause the mark to be published in the Official Gazette of the Patent Office: *Provided,* That in the case of an applicant claiming concurrent use, or in the case of an application to be placed in an interference as provided for in section

16 of this Act, the mark, if otherwise registrable, may be published subject to the determination of the rights of the parties to such proceedings (Amended by Public Law 772, 87th Cong., approved Oct. 9, 1962, 76 Stat. 769).

Section 12(b) (15 U.S.C. 1062b). Examination of application—Refusal of registration when not entitled....

If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of 6 months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of 6 months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Commissioner that the delay in responding was unavoidable, whereupon such time may be extended.

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Section 13 (15 U.S.C. 1063). Opposition to registration of marks on the principal register

Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the required fee, file a verified opposition in the Patent Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. For good cause shown, the time for filing opposition may be extended by the Commissioner, who shall notify the applicant. An unverified opposition may be filed by a duly authorized attorney, but such opposition shall be null and void unless verified by the opposer within a reasonable time after such filing to be fixed by the Commissioner. An opposition may be amended under such conditions as may

be prescribed by the Commissioner (Amended by Public Law 772, 87th Cong., approved Oct. 9, 1962, 76 Stat. 769).

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Section 41 (15 U.S.C. 1123). Commissioner to make rules for proceedings in the Patent Office

The Commissioner shall make rules and regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office under this Act.

APPENDIX C-2

Application for Registration

2.21 *Parts of application.* A complete application for registration comprises:

(a) A written application (see rules 2.31 to 2.47);

(b) A drawing of the mark (see rules 2.51 to 2.55);

(c) Five specimens or facsimiles (see rules 2.56 to 2.58);

(d) The required filing fee;

(e) A certification or a certified copy of the registration in the country of origin if the application is based on such foreign registration pursuant to section 44(e) of the act (see rule 2.39).

AUTHORITY NOTE: Rules 2.21 to 2.47 interpret or apply sec. I, 60 Stat. 427; 15 U.S.C. 1051.

2.22 *Application must be complete to receive filing date.* An application will not be considered filed unless all the required parts specified in rule 2.21, complying with the rules relating thereto, are received, but minor informalities may be waived subject to subsequent correction. If the papers are incomplete or so defective that they cannot be accepted, the applicant will be notified and the papers and fee held six months for completion. If the application is not completed within such time, the papers and fee will be returned to the applicant or otherwise disposed of; the

drawing or fee of an unaccepted application may be transferred to a later application.

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2.33 *Requirements for application.* (a) (1) The application shall include a request for registration and shall specify:

(i) The name of the applicant;

(ii) The citizenship of the applicant; if the applicant be a partnership, the names and citizenship of the general partners or, if the applicant be a corporation or association, the state or nation under the laws of which organized;

(iii) The domicile and post office address of the applicant;

(iv) That the applicant has adopted and is using the mark shown in the accompanying drawing;

(v) The particular goods on or in connection with which the mark is used;

(vi) The class of merchandise according to the official classification, if known to the applicant;

(vii) The date of applicant's first use of the mark as a trademark on or in connection with goods specified in the application (see rule 2.38);

(viii) The date of applicant's first use in commerce of the mark as a trademark on or in connection with goods specified in the application, specifying the nature of such commerce (see rule 2.38);

(ix) The mode, manner or method of applying, affixing or otherwise useing the mark on or in connection with the goods specified.

(2) If more than one item of goods is specified in the application, the dates of use required in subparagraph (1) (vii) and (viii) of this paragraph need be for only one

of the items specified, provided the particular item to which the dates apply is designated.

(3) The word "commerce" as used throughout this part means commerce which may lawfully be regulated by Congress, as specified in section 45 of the act.

(b) The application must also include averments to the effect that the applicant or other person making the verification believes himself or the firm, corporation, or association in whose behalf he makes the verification to be the owner of the mark sought to be registered; that the mark is in use in commerce, specifying the nature of such commerce; that no other person, firm, corporation, or association, to the best of his knowledge and belief, has the right to use such mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when applied to the goods of such other person, to cause confusion, or to cause mistake, or to deceive; that the specimens or facsimiles show the mark as actually used in connection with the goods; and that the facts set forth in the application are true.

(c) For an application for the registration of a mark for goods or services falling within a plurality of classes, see rule 2.87.

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Drawing

AUTHORITY NOTE: Rules 2.51 to 2.55 interpret or apply sec. 1, 60 Stat. 427; 15 U.S.C. 1051.

2.51 *Drawing required.* (a) The drawing of the trademark shall be a substantially exact representation thereof as actually used on or in connection with the goods.

(b) The drawing of a service mark shall be a substantially exact representation of the mark as used in the sale or advertising of the services. The drawing of a service mark may be dispensed with in the case of a mark not

capable of representation by a drawing, but in any such case the application must contain an adequate description.

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(d) If the application is for the registration only of a word, letter or numeral, or any combination thereof, not depicted in special form, the drawing may be the mark typed in capital letters on paper, otherwise complying with the requirements of rule 2.52.

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Specimens

AUTHORITY NOTE: Rules 2.56 to 2.58 interpret or apply sec. 1, 60 Stat. 427; 15 U.S.C. 1051.

2.56 *Specimens.* The five specimens of a trademark shall be specimens of the trademark as actually used on or in connection with the goods in commerce, and shall be duplicates of the actually used labels, tags, or containers, or the displays associated therewith or portions thereof, when made of suitable material and capable of being arranged flat and of a size not larger than the size of the drawing.

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Examination of Application and Action by Applicants

AUTHORITY NOTE: Rules 2.61 to 2.69 interpret or apply sec. 12, 60 Stat. 432; 15 U.S.C. 1062.

2.61 *Action by Examiner.* (a) Applications for registration will be examined or caused to be examined by the Examiner of Trademarks, and, if the applicant is found not entitled to registration for any reason, he will be so notified and advised of the reasons therefor and of any formal requirements or objections.

(b) The Examiner may require the applicant to furnish such information and exhibits as may be reasonably necessary to the proper examination of the application.

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2.63 *Re-examinations.* After response by the applicant, the application will be re-examined or reconsidered, and if the registration is again refused or formal requirements insisted upon, but not stated to be final, the applicant may respond again.

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Amendment of Application

AUTHORITY NOTE: Rules 2.71 to 2.75 interpret or apply sec. 12, 60 Stat. 432; 15 U.S.C. 1062.

2.71 *Amendments to application.* (a) The application may be amended to correct informalities, or to avoid objections made by the Patent Office, or for other reasons arising in the course of examination. No amendments to the dates of use will be permitted unless such changes are supported by affidavit by the applicant and by such showing as may be required by the Examiner.

(b) Addition to the specification of goods or services will not be permitted unless the mark was in actual use on all of the goods or services proposed to be added by the amendment at the time the application was filed and unless the amendment is accompanied by additional specimens (or facsimiles) and by a supplemental affidavit by the applicant in support thereof.

(c) Amendment of the verification will not be permitted. If that filed with the application be faulty or defective, a substitute or supplemental verification must be filed.

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Publication and Allowance

2.81 *Publication in Official Gazette.* If, on examination or re-examination of an application for registration on the Principal Register, it appears that the applicant is entitled to have his mark registered, the mark will be published in the Official Gazette for opposition. The

mark also may be so published in the case of an application to be placed in interference or concurrent use proceeding, if otherwise registrable.

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2.84 *Jurisdiction over published or allowed applications.* (a) After ~~publication or~~ allowance the Examiner may exercise jurisdiction over an application by special authority from the Commissioner.

(b) Amendments may be made after the allowance of an application if the certificate has not been printed, on the recommendation of the Examiner approved by the Commissioner, without withdrawing the allowance.

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Opposition

AUTHORITY NOTE: Rules 2.101 to 2.106 interpret or apply secs. 13, 17, 60 Stat. 433, 434; 15 U.S.C. 1063, 1067.

2.101 *Time for filing opposition.* Any person who believes that he would be damaged by the registration of a mark upon the Principal Register may, upon payment of the required fee, oppose the same by filing a verified opposition in the Patent Office within thirty days after the publication (rule 2.81) of the mark sought to be registered.

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2.104 *Contents of opposition.* The opposition must allege facts tending to show why the opposer would be damaged by the registration of the opposed mark and state the specific grounds for opposition. A duplicate copy of the opposition including exhibits shall be filed.

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2.107 *Amendment of opposition.* An opposition may be amended in the same manner and to the same extent as a complaint in a civil action before a United States district court. See Rule 15 of the Federal Rules of Civil Procedure.

Petitions and Action by the Commissioner

2.146 *Petition to the Commissioner.* (a) Petition may be taken to the Commissioner (1) from any repeated action or requirement of the Examiner of Trademarks, not subject to appeal under rule 2.141, in the ex parte prosecution of an application; (2) in cases in which the statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Any brief in support thereof should accompany or be embodied in the petition; in contested cases any brief in opposition shall be filed within fifteen days after service of the petition. Where facts are to be proved in ex parte cases (as in a petition to revive an abandoned application), the proof in the form of affidavits (and exhibits, if any) must accompany the petition.

(c) An oral hearing will not be held except when considered necessary by the Commissioner.

(d) The mere filing of a petition will not stay the period for replying to an Examiner's action, nor stay other proceedings.

(e) Authority to act on a petition may, when appropriate, be delegated by the Commissioner.

(f) No fee is required for a petition to the Commissioner.

2.147 *Cases not specifically defined.* All cases not specifically defined and provided for by the rules in this part will be decided in accordance with the merits of each case under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

2.148 *Commissioner may suspend certain rules.* In an extraordinary situation, when justice requires and no other party is injured thereby, any requirement of the rules in this part not being a requirement of the statute may be suspended or waived by the Commissioner.

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